



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------|------------------|
| 10/070,218 | 07/19/2002 | Peter Cole Goodwin | 131279.1016 | 9610 |
| 60148 7590 10/12/2007 GARDERE / JAMES HARDIE GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201 | | | EXAMINER MARCANTONI, PAUL D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1793 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 10/12/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/070,218

Applicant(s)

GOODWIN ET AL.

Examiner

Paul Marcantoni

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/18/07 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12, 14-16, 18-20, 22 and 52-78 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 52-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 14-16, 18-19, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1793

The applicants' 9/18/07 RCE filing is acknowledged.

Non-Elected Claim:

Claim 20 is a non-elected claim for the reasons provided in earlier office communications (office actions, advisory, etc.) It is a claim withdrawn.

Non-Elected by Original Presentation:

Applicants' submission of new method claims 52-78 are non-elected by original presentation as applicants original claims were only directed to the product or composition. Method claims are a new statutory class of invention and are thus withdrawn from consideration.

New Matter:

Claim 12 is rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The terms "to less than 0.2%" by weight of (dry solid...) of sulphonated dispersion agent is new matter. There is no literal support for "to less than 0.2% from the original disclosure.

35 USC 102:

Claims 12, 14-16, 18-¹⁹~~20~~, and 22 are anticipated under 35 USC 102(b) over Valore '231 or Sobolev et al. '289 B2.

See previous office actions for further analysis.

Note: Rirsch has been withdrawn because it teaches no cellulose.

Art Unit: 1793

35 USC 103 :

Claims 12, 14-16, 18-¹⁹~~20~~, and 22 are rejected under 35 USC 103(a) as obvious over Hayakawa et al. '086, Valore '231, or Sobolev '289 B2 alone or in view of Downing et al. '199.

Note: Rirsch is withdrawn from the rejection because they do not teach cellulose.

The rejections are the same as in the previous final rejection and more detailed analysis of each reference can be found in that office action. The only revision over the final rejection is that Hayakawa et al. '086 is now a primary reference (this was also discussed in applicants' specification). Hayakawa does not teach the addition of a dispersant or dispersing agent such as a sulfonated dispersant. Yet, the addition of a dispersant to cement compositions is a conventional additive to cement and its addition would have been an obvious design choice for one of ordinary skill in the art. The applicants are also referred to their original disclosure and it teaches on page 6 sulfonated dispersants but also non-sulfonated dispersants (See list in lines 24-28, second to last paragraph). Thus, applicants only difference over the Hayakawa reference is adding a dispersant; a common and conventional additive to cement. Downing et al. '199, nevertheless, teach that adding a dispersing agent to a cement is conventional in the art (col.1 last line and col.2, lines 1-24).

Response to Remarks:

Valore:

Applicants allege that in light of their amendment to less than 0.2% for sulfonated dispersing agent, Valore no longer applies. Valore teaches a minimum amount of

Art Unit: 1793

dispersant in his cement composition of 0.2%. In rebuttal, applicants' amendment is new matter not literally supported by original disclosure. The applicants provide no examples for 0.2% or even less than this amount over a range of data points to support this newly added limitation. The applicants only have the teaching of the broad range and the endpoints.

Rirsch:

This reference is withdrawn because it does not teach cellulose which is now claimed in claim 12.

Sobolev et al:

Sobolev, like Valore, has been maintained in the rejection because applicants amendment of "less than 0.2% is new matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1793

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Paul Marcantoni", with a stylized flourish at the end.

Paul Marcantoni
Primary Examiner
Art Unit 1793